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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/131,710	08/10/98	PAZ-PUJALT	G 78137RLO

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IM62/0302

EXAMINER

GRENDZYNSKI, M

ART UNIT

PAPER NUMBER

1774

3

DATE MAILED:

03/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/131,710

Applicant(s)

Paz-Pujalt et al.

Examiner

Grendzynski, Michael E.

Group Art Unit

1774



☒ Responsive to communication(s) filed on Aug 10, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-12 is/are pending in the applicat

Of the above, claim(s) 3-12 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 2 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-12 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-2, drawn to an image-receiving article, classified in class 428, subclass 195.
 - II. Claims 3-12, drawn to a method of forming a receiver, classified in class 156, subclass .
2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another, materially-different process, e.g., forming a hydrophilic layer on a temporary carrier layer, forming the water-based colorant image on the hydrophilic layer, then transferring the layer/image to the hydrophobic protective layer.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Raymond Owens on 2/9/00, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-2. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 U.S.C. § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Presently, the specification does not teach what comprises the clear hydrophobic layer.

8. Claims 1-2 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a clear hydrophilic layer, does not reasonably provide enablement for a hydrophilic layer generally (e.g., one that is not clear). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Presently, it is unclear exactly what comprises the clear hydrophobic layer. It is not defined in the specification, nor does it have a well-known composition in the art.

Regarding claims 1-3, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 U.S.C. § 103

11. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mouri in view of Bodager. Applicants claim an article comprising, in order, (1) a support; (2) an information-receiving layer; (3) a clear hydrophobic layer; and (4) a hydrophilic layer capable of receiving a water-based image. Additionally, there may be a barrier layer located between the support and the information-receiving layer. Mouri discloses a recording medium comprising a substrate, an under layer, and an upper layer. See col. 4, lines 4-6 and FIG. 1. The substrate is equivalent to applicants' support--it is comprised of a polyester resin. See col. 5, line 67. The underlayer, moreover, is equivalent to applicants' information-receiving layer. It is comprised of gelatin. See col. 6, lines 11-16. The upper layer is equivalent to applicants' hydrophobic layer. It is comprised of a water-resistant polymeric material. See col. 32, lines 59-65. Bodager teaches inkjet media which may be laminated to a permanent substrate to provide that substrate with any desired ink design. See FIG. 1 D, col. 12, lines 31-50 and col. 13, lines 13-16. Bodager does not limit the permanent substrate upon which the media may be transferred. See e.g., col. 12, lines 31-50. The ink-receiving layer of Bodager is comprised of polyvinyl pyrrolidone, thus, is equivalent to applicants' hydrophilic layer. See col. 5, lines 5-7. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the imaged recording

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medium of Mouri with Bodager inkjet media, motivated by the desire to provide the recording medium with a preferred ink design, as taught by Bodager on col. 13, lines 13-21.

12. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeyama in view of Jaeger. Takeyama discloses an thermal transfer image-receiving sheet comprising (1) a substrate and (2) an image-receiving layer which is imaged with a thermally-diffusible dye. *See* col. 1, lines 19-25. A sublayer may be provided between the substrate and image-receiving layer to provide barrier properties. *See* col. 7, lines 59-63. On the image-receiving layer, a protective layer is provided over the imaged image-receiving layer. *See* col. 14, lines 17-20 and col. 15, line 67 through col. 16, line 2. The protective layer comprises a hydrophobic polyester resin. *See* col. 17, line 6. Jaeger teaches that it is well known in the art to provide a substrate such as a polyester resin (e.g., polyethylene terephthalate) with a hydrophilic material (e.g., polyvinyl pyrrolidone) to enable the substrate to sufficiently absorb ink. *See* col. 2, lines 1-33. It would have obvious to one of ordinary skill in the art at the time of the invention to provide the hydrophobic polyester resin layer of the Takeyama image-receiving sheet with the hydrophilic coating of Jaeger, motivated by the desire to enable the hydrophobic layer to receive aqueous inks, as taught by Jaeger on col. 2, lines 1-33.

Conclusion

13. Should you have any questions concerning this communication, please direct them to Michael E. Grendzynski at telephone number (703) 305-0593. The examiner can be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, William Krynski, can be reached at (703) 308-2376. Please allow the examiner twenty-four hours to return your call.

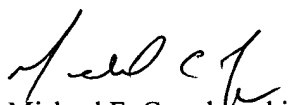
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A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes, and (703)305-5408 for all other official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2351.



**BRUCE H. HESS
PRIMARY EXAMINER
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Assistant Examiner
February 28, 2000